

**R E M A R K S**

- Claims 49 – 69 are currently pending and stand rejected;
- Upon entry of the present amendments, which are respectfully requested:
  - claim 69 will be cancelled without prejudice or disclaimer, and
  - claim 53 will be amended to be more consistent with the language of claim 49, from which it depends.

1. Claim Rejections – 35 U.S.C. §112, first paragraph

Claim 69 stands rejected 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Office has identified several terms or clauses from this rejected claim that it is asserting are not supported by the specification as filed. In particular, the Office has asserted that the limitation of “that the wagering game has been mandated by a regulatory authority to only be played while a specified feature is enabled...the authorization code indicating whether the wagering game has only been allowed to be played while the feature was enabled” are not supported by the specification as filed.

Although Applicants do not agree with the Office’s assessment that the embodiment claimed in claim 69 is not sufficiently described in the specification, Applicants have cancelled claim 69 herein, to streamline and advance the prosecution of the present Application. Applicants intend to pursue the embodiment of claim 69 in a continuing application.

Claims 69 (at least Applicants believe it to have been intended to be claim 69, even though the Office Action refers to claim 16 in this rejection, which claim is no longer pending) further stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants respectfully submit that this rejection is moot since claim 69 will be cancelled upon entry of the present amendments.

2. Claim Rejections – 35 USC §102(c)

Claims **49, 50, 53, 54, 57, 59, 60, 63, 64 and 67** stand rejected under 35 U.S.C. 102(c) as allegedly being anticipated by U.S. Patent No. 6,962,530 (Publication No. 2003/02037756 to Jackson (“Jackson” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

A reading of the rejections of claims **49, 50, 53, 54, 57, 59, 60, 63, 64 and 67** reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Thus, the Examiner has not provided evidence that all of the claimed subject matter of any claim was known at the time of invention. Accordingly, the Examiner has not presented a *prima facie* case of anticipation of any claim.

Anticipation requires identity of the claimed process and a process of the prior art; the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. Minnesota Min. & Mfg. Co., v. Johnson & Johnson Orthopedics, Inc., 976 F.2d 1559 (Fed. Cir. 1992); Glaverbel S.A. v. Northlake Mkt’g & Supp., Inc., 45 F.3d 1550 (Fed. Cir. 1995).

The elements of the claim must either be inherent or disclosed expressly in the reference. Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560 (Fed. Cir. 1988).

There must not be any differences between the claimed invention and the prior art disclosure, as viewed by a person of ordinary skill in the art, for anticipation to exist. Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991). Thus, the absence of any claim element from the reference negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565 (Fed. Cir. 1986).

Further, “[f]or a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. See In re Spada, 911 F.2d 705, 708, 15 U.S.P.Q.2D (BNA) 1655, 1657 (Fed. Cir. 1990) (‘The [prior art] reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it.’ (citations omitted)). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings

that are not there. An expert's conclusory testimony, unsupported by the documentary evidence, cannot supplant the requirement of anticipatory disclosure in the prior art reference itself. See Jamesbury Corp. v. Litton Indus. Prods., Inc., 756 F.2d 1556, 1563, 225 U.S.P.Q. (BNA) 253, 257-58 (Fed. Cir. 1985)". Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461 (Fed. Cir. 1997).

Also, the elements in the prior art must be arranged as they are in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226 (Fed. Cir. 1988).

Applicants respectfully submit that Jackson fails to teach or suggest the following limitations of the claims as follows:

With respect to independent claim **49** (and thus all claims dependent therefrom and including the same limitations):

- *prior to allowing play of a wagering game with a particular feature and via a processor of a device operable to facilitate the wagering game, determining whether an authorization code for enabling play of the wagering game with the particular feature has been received from a regulatory authority;*
- *verifying, via the processor, an expiration condition for the authorization code; and*
- *only if the expiration condition has not yet been met, allowing play of the wagering game with the particular feature*

With respect to independent claim **59** (and thus all claims dependent therefrom and including the same limitations):

- *prior to allowing play of a wagering game on a particular gaming device, determining via a processor of a device operable to facilitate the wagering game whether an authorization code for enabling play of the wagering game on the particular gaming device has been received from a regulatory authority;*

- *verifying, via the processor, an expiration condition for the authorization code; and*
- *only if the expiration condition has not yet been met, allowing play of the wagering game on the particular gaming device*

Jackson is directed to particular methods of verifying that the code for a game or feature of a game has not been tampered with or altered from a state in which it was approved by a regulatory agency or provided by a manufacturer of the game. The stated objective in Jackson is “to ensure the security of the exchanged data...ensuring that such data is not altered or forged.” Col. 15: 22 – 31. In other words, the Jackson system is an authentication system for casino games (as evidenced by the title and written description as a whole). As explained by Jackson: “The essential objective of authentication programs is to provide near absolute assurance that data stored in memory has not been corrupted, violated, altered or otherwise changed from the original data placed into memory.” Col. 15: 44 – 47.

The claimed embodiments, on the other hand, are directed towards verifying whether an authorization code has been received, not for purposes of verifying the integrity or authenticity of game software (which may still need to be performed in various circumstances) but rather to verify that a game has been enabled or approved for play with a particular feature (in the case of claim 49 and claims dependent therefrom) or on a particular gaming device (in the case of claim 59 and claims dependent therefrom).

As a preliminary matter (before analysis of the claim limitations and providing arguments as to why Jackson does not describe the claim limitations), Applicants note that verifying that a wagering game has been authorized for play with a particular feature or for a particular gaming device is a very distinct problem and process from verifying the authenticity or integrity of software or code. They are mutually exclusive in the sense that performing one does not remove the need to perform the other. Applicants have even acknowledged this in the specification as filed, in explaining that “According to some embodiments, an authorization code may be generated in a manner so as to prevent, discourage, or make computationally infeasible forgery of authorization codes (e.g., using cryptographic techniques).” Specification as filed, page 77, lines 21 – 23. In other

words, the authentication of game code as described in Jackson may need to be performed in some embodiments of Applicants' invention, to verify that software code is has not been violated, tampered with or corrupted but this is not equivalent to verifying (by verifying that an appropriate and unexpired authentication code has been received) that a wagering game has been enabled or approved for play with a particular feature (claim 49) or on a particular gaming device (claim 59).

Applicants respectfully submit that a close scrutiny of the Office's interpretation and application of the teachings of Jackson not only fails to support a *prima facie* case of anticipation but would also render Jackson unsatisfactory for its intended purpose (which makes a case of anticipation unsustainable).

Jackson describes that one method of verifying that software code has not been tampered with, violated or corrupted entails having a first party (which can be a regulatory agency, as the Office notes) encrypt the originally approved software code with its private key or digital signature, which is only known to that first party. To subsequently verify the authenticity and integrity of that encrypted code, a casino may use a corresponding public key (the public key corresponding to the private key/digital signature with which the encrypted code was originally signed) to decrypt the software code. The software code can only be successfully decrypted with the intended signer's public key; thus, successful decryption of the encrypted code provides "a degree of certainty that the data was signed or encrypted by the intended signer." Col. 16: 42 – 53.

The Office has taken the position that the digital signature/private key of the entity encrypting/signing the code in Jackson is equivalent to the "authorization code" recited in the claimed embodiments. Current Office Action, page 5: "...parg. 106 discloses regulatory authorities providing digital signatures interpreted as an authorization code in wager game systems." However, Applicants point out that Jackson does not describe a regulatory agency providing its digital signature or private key to the casino. Rather, Jackson describes the regulatory agency as *using* its digital signature or private key to encrypt the code they have approved, as is the common practice for the private key/public key verification process being utilized by Jackson. Thus, the Office's interpretation of the digital signature/private key being the authorization code renders the remainder of its position untenable in terms of this particular limitation of the claims

being taught by Jackson. This is because, in both claim 49 and claim 59, it is determined whether the authorization code *has been received from a regulatory authority*. Thus, in order for Jackson to describe this claim limitation, Jackson would have to describe the casino as receiving the regulatory agency's digital signature/private key. Jackson most emphatically does not teach this. In Jackson, there is no step of determining whether the digital signature/private key has been received from the regulatory authority. As explicitly taught by Jackson, the digital signature/private key must remain private and with the entity (in the Office's scenario, the regulatory agency) who uses it to encrypt and sign the code. "Because only the intended signer knows his private key..." Col. 16: 42 – 53. If the regulatory authority were to provide this to the casino or any other entity, the integrity and reliability of the entire authentication process of Jackson would be rendered unsatisfactory for its intended purpose. The casino (or any entity interested with verifying the authenticity of the code) uses the corresponding *public key* to decrypt the encrypted code and verify its authenticity, *not the private key or digital signature*. Thus, again and for emphasis, the private key/digital signature (which the Office is interpreting as being equivalent to the authentication code of the claimed embodiments) is *never received* by the casino or other entity performing any verification method.

Next, in the claimed embodiments, the same entity that determines (in the first claimed step) whether an appropriate authorization code was received from a regulatory authority then performs verifying, via the processor, an expiration condition for the authorization code. While Jackson describes that a digital signature/private key may have associated therewith an expiration date, Jackson does not describe the casino as determining the expiration condition for the digital signature/private key. Rather, Jackson merely describes that the verification process will no longer work if the digital signature/private key used for initially encrypting the code has expired.

Finally, claims 49 and 59, respectively, provide for (i) only if the expiration condition has not yet been met, allowing play of the wagering game with the particular feature (in the case of claim 49) and (ii) only if the expiration condition has not yet been met, allowing play of the wagering game on the particular gaming device (in the case of claim 59). In Jackson, a public key must be successfully used to decrypt the game code (and the result must correspond to an expected result) before a determination is made that

the game code has been successfully verified as being authentic, not tampered with, not corrupt. Even if it were determined that the digital signature/private key originally used to encrypt the game code were not yet expired, such a determination would be insufficient to allow game play to be allowed. For example, the digital signature/private key may indeed be unexpired but if the game code were to have been tampered with, violated or become corrupt, the result of the decryption using the corresponding public key would not match the expected result and the game code would correctly be determined to be unverified and unsuitable for game play. Relying solely on the expiration or lack of expiration of the digital signature/private key would render the authentication system of Jackson unsuitable for its stated purpose: to verify that the game code has not been tampered with, violated or become corrupt. Thus, an essential element of Jackson is to use the corresponding public key to decrypt the code and compare the result to an expected result before allowing game play to proceed.

For the above reasons, Applicants respectfully request that the rejection over Jackson should be withdrawn.

3. Claim Rejections – 35 U.S.C. §103(a)

Claims **51, 52, 55, 56, 61, 62, 65 and 66** stand rejected under 35 U.S.C. §103(a) as being obvious over Jackson in view of U.S. Patent Publication No. 2002/0071557 (“Nguyen” herein). Applicants respectfully traverse this rejection. As Nguyen does not cure the deficiencies of Jackson, Applicants respectfully submit that claims **51, 52, 55, 56** (each dependent from claim **49**) and claims **61, 62, 65 and 66** (each dependent from claim **59**) are patentable at least for the same reasons as claims **49 and 59**.

Claim **69** stands rejected under 35 U.S.C. §103(a) as being obvious Nguyen in view of Jackson. Since claim **69** has been cancelled herein, Applicants respectfully submit that this rejection is now moot.

Applicants silence with respect to the Office’s other various assertions not explicitly addressed in this paper, including assertions of (1) what the cited reference(s) teach or suggest, (2) the Office’s interpretation of claimed subject matter or the Specification and (3) assertions of what knowledge was generally known in the art at the

time of invention, is not to be understood as agreement with the Office. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.



### **Conclusion**

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham via the contact information provided below.

### **Authorization to Charge Fees**

Applicants believe that a one month extension of time is required to make this Amendment and Response timely. Accordingly, please grant a petition for a one month extension of time necessary to make this submission timely. Additionally, please charge any fees required for this submission, including a one month extension of time fee as follows:

Deposit Account: 50-0271

Order No. 02-034

Charge any additional fees or credit any overpayment to the same account.

Respectfully submitted,

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Date

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